

ESTTA Tracking number: **ESTTA81656**

Filing date: **05/20/2006**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92044697
Party	Plaintiff ACM ENTERPRISES, INC.  ,
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Submission	Reply in Support of Motion
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Date	05/20/2006
Attachments	2006-05-20 reply brief motion to compel martello 01.pdf ( 4 pages )(29516 bytes ) EXH R-01 2006-04-20 eltr tesser re discovery.pdf ( 3 pages )(280351 bytes ) EXH R-02 2005_12_09 resp resp 1st interrog martello.pdf ( 3 pages )(356670 bytes )

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE  
THE TRADEMARK TRIAL AND APPEAL BOARD

ACM Enterprises, Inc.,

Petitioner,

- against -

Martello, Jeannette, M.D.

Respondent.

Cancellation No.: 92044697

Filed: July 1, 2005

PETITIONER'S REPLY BRIEF IN MOTION TO COMPEL FURTHER  
RESPONSES (TBMP 523)

Pursuant to 37 CFR 2.127 of the Trademark Rules of Practice and TBMP 523,  
Petitioner ACM ENTERPRISES, INC. respectfully presents this reply brief.

1. Three Weeks of Extensions Were Given and Petitioner Was Within Its Rights to File  
Motion to Compel.

Petitioner has been very patient and fair to the Respondent. Considering that  
Petitioner provided an extension of 3-weeks of time to respond and to produce documents  
to the Feb. 22, 2006 requests, Petitioner is well within its rights to file this Motion to  
Compel.

Also, by providing a courtesy of 3-weeks of time to Respondent, the Petitioner  
was left with very little time to review any responses and to communicate with  
Respondent. The Respondent's mailed April 14, 2006 Responses were received by  
Petitioner's counsel on Wed., April 19, 2006. (See Motion to Compel, Exhibit B).  
However, these responses were incomplete and did not provide any documents.

The deadline to file a motion to compel was Friday, April 21, 2006, which is before the beginning of the Sat., April 22, 2006 Trial Period for Petitioner. Upon receipt on Wed., April 19, 2006 of the Respondent's responses, Petitioner only had three days to review the April 14, 2006 responses, communicate with Respondent's counsel by telephone and written letter, and then prepare a motion to compel by the Friday, April 21, 2006 deadline.

Please note that Mr. Hong's April 20, 2006 letter to Respondent's counsel was mailed and e-mailed to Respondent's counsel and clearly outlined any outstanding issues with the April 14, 2006 responses. See Exhibit R-01 (Copy of April 20, 2006 e-mail, 3 pages).

This short time period was due to (1) Respondent providing inadequate responses and no documents on the last day of the 3-week extension period and (2) Petitioner extending the time for Respondent to respond to the outstanding discovery. By extending such courtesy to the Respondent, Petitioner should not be prejudiced in being able to assert its right to file motions to compel discovery responses. Respondent should simply provide the documents requested and promised.

## 2. Information from Sara Herrick Is Very Relevant to this Case.

Respondent has asserted use of Ms. Sara Herrick for the mark "SKIN DEEP SKIN CARE" in the Respondent's Dec. 9, 2005 Responses to the Petitioner's First Set of Interrogatories (Interrogatory No. 4). See Exhibit R-02 (Dec. 9, 2005 Respondent's Responses to Petitioner's First Set of Interrogatories, pages 1-3).

The questions asked in the Petitioner's Second Set of Discovery were a natural follow-up to this new information and should have been expected to be asked when

Respondent presented a Dec. 14, 2005 assignment from Sara Herrick to Respondent Jeannette Martello, M.D. and asserted an earlier date of use of the mark.

In light of this Dec. 14, 2005 assignment, Respondent had more than ample time (at least four months from the Dec. 14, 2005 Assignment to the April 21, 2006 Motion to Compel) to consider that Petitioner would question Ms. Herrick's use of the mark in this proceeding and to produce relevant documents and information to defend this use of the mark in this Cancellation Proceeding.

While extremely unfortunate, Ms. Herrick's illness is not relevant to this proceeding. If Respondent attempts to rely on Ms. Herrick's use of the mark "SKIN DEEP SKIN CARE," Respondent must be prepared to provide documents and responses within the deadlines and in a timely manner. Promises are not proper responses.

### 3. Conclusion

For the reasons stated above and in the April 21, 2006 Motion to Compel, Petitioner respectfully requests that the Board grant Petitioner's motion to compel as soon as the Rules allow, to issue such an order, and to reset the Trial Testimony dates.

DATED: May 20, 2006

By: /david hong, reg #45704/  
David Hong, Esq.  
(CA SBN 195795, Reg. No. 45,704)  
Attorney for Petitioner,  
ACM ENTERPRISES, INC.

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Attorney File No. 2005-02-0107

Certificate of Service

I hereby certify that I am not a party to this case and a true and correct copy of the following document(s): PETITIONER'S REPLY BRIEF (including Exhibits R-01, R-02) was sent by electronic mail and first class U.S. Mail on MAY 20, 2006 in an envelope addressed to:

Mr. Brandon Tesser, Esq.  
TESSER & RUTTENBERG  
12100 Wilshire Blvd., Suite 220  
Los Angeles, CA 90025  
E-Mail: btesser@tesser-ruttenberg.com  
Attorney for Respondent, Jeannette Martello, M.D.

By: /david hong, reg #45704/  
David Hong (Reg. No. 45,704)



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Date: Thu, 20 Apr 2006 15:11:38 -0700 (PDT)  
From: "David Hong" <david\_hong@sbcglobal.net>  
Subject: acm v. martello  
To: btesser@tesser-ruttenberg.com

April 20, 2006

Mr. Brandon Tesser, Esq.  
TESSER & RUTTENBERG  
12100 Wilshire Blvd., Suite 220  
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VIA MAIL & E-MAIL: [btesser@tesser-ruttenberg.com](mailto:btesser@tesser-ruttenberg.com)

Re: Client: ACM Enterprises, Inc./Skin Deep Laser Med Spa  
CANCELLATION NO. 92044697  
ACM Enterprises, Inc. vs. Jeannette Martello, M.D.  
Petition to Cancel Registration No. 2932593 (Pet. Filed July 1, 2005)  
Serial No. 76581387 (filed March 15, 2004) - Mark: "SKIN DEEP"  
Attorney File No. 2005-02-0107

Dear Brandon:

This letter is regarding the April 14, 2006 Respondent's discovery responses, and a follow up to our telephone conversation today.

Petitioner served Requests for Admissions, Interrogatories, and Documents on Feb. 22, 2006. These responses were due in 30 days or March 24, 2006; Petitioner granted two extensions on March 23, 2006 (2-week ext.) and also on April 6, 2006 (1-week ext.), which totaled three additional weeks to a new deadline of April 14, 2006.

Your associate, Michelle Decasas, Esq., telephoned me on April 14, 2006 to request a third extension to respond; Ms. Decasas stated that due to the third party Ms. Sara Herrick's illness, you were not able to obtain the requested information and documents from Ms. Herrick.

Considering the already granted three weeks to respond, my client declined to grant another extension of time. Ms. Decasas informed me that your office would be providing objections to the Request for Documents and Interrogatories and a response to the Request for Admissions. I received your client's April 14, 2006 Responses on Wed., April 19, 2006.

#### Requests for Production of Documents

For Requests No. 17-21 and 25-31, Respondent replied that Petitioner will produce all responsive documents within her possession, custody, or control, if there are. As of today, I have not yet received any documents in response to the Feb. 22, 2006 Requests.

In response to your objections to Requests No. 22-24, we sent these questions to further obtain relevant evidence as to the receipts and invoices that Dr. Martello allegedly used with the Mark for the patients that she identified and provided in her trademark applications. In other words, it is reasonable to ask any additional invoices and receipts for those same patients prior to and after the listed Feb. 2004 dates on the specimen invoices.

#### Interrogatories:

For Interrogatories No. 20, 21, and 22, your client only responded with objections, and we formally request a further response.

#### **Petitioner Exhibit R-01**

For Interrogatories No. 20, 21, and 22, your client only responded with objections and pursuant to FRCP 33(d) by producing business records and documents which contains the requested information. We ask again for these documents, and we not received any documents as

**Cancellation No. 92044697**

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of the date of this letter.

For Interrogatory No. 24, this interrogatory is clear and specific as to:

1. Time: Jan. 1, 2003 to Jan. 1, 2005.
2. Location: Respondent's Pasadena, CA Office.
3. Item/Document: Invoices.

As a result, we request a further response to this interrogatory. This interrogatory seeks relevant information because the Respondent submitted invoices (from approximately Feb. 2004) for her trademark applications.

Requests for Admissions (RFA):

RFA No. 12-14 request information regarding permanent signs. Your client objected as to "permanent" being vague and ambiguous; however, your client was able to understand the difference between "permanent" and a sign that "could be removed relatively easily." (See Respondent's 4-14-2006 Response to Request for Admission No. 12). As a result, we request further responses to RFA No. 14 and 15.

RFA No. 15, Petitioner requests a further response to regarding use of the terms "866WOMANDR" and "DOCTORMARTELLO.COM" during her FM 97.1 KLSX "SKIN DEEP" radio show. Petitioner requests that Respondent use the common dictionary definitions for "used" and "during" in responding to this request.

RFA No. 16-18, Petitioner requests a further response since this request is for relevant information regarding use of the marks "SKIN DEEP, SKIN DEEP LASER, and SKIN DEEP LASER MEDSPA," which are relevant to this proceeding.

Deadline to File Motion to Compel Discovery is APRIL 21, 2006

TBMP 523 & 524 and 37 CFR 2.120(e) require that any motions to compel need to be filed prior to the testimony period. Here, the Petitioner's testimony period starts Sat., April 22, 2006. As a result, I must file any Motions to Compel by Friday, April 21, 2006.

If I do not file any such motions, TBMP 523.04 states, "if a party that served a request for discovery receives a response thereto which it believes to be inadequate, but fails to file a motion to test the sufficiency of the response, it may not thereafter be heard to complain about the sufficiency thereof."

During our telephone conversation today, you informed me that you do not have the requested documents and information from your client, and I informed you that I will have to file a motion to compel to preserve my client's rights by Friday, April 21, 2006.

After the motion to compel is filed and served, and if your client provides the requested documents and information prior to your due date to respond to the motion, we have the option of taking the motion to compel off calendar.

This letter is to comply with the TBMP 523-524 and 37 CFR 121 requirements to meet and confer prior to filing any motions to compel discovery.

Very truly yours,

David Hong, Esq.

David Hong, Esq.,  
LAW OFFICE OF DAVID HONG  
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**Cancellation No. 92044897**

Attachments

Files:

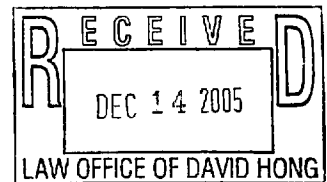


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7  
8 **IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
9 **BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

10  
11 ACM ENTERPRISES, INC.,

12 Petitioner,

13 vs.

14 JEANNETTE MARTELLO, M.D.,

15 Respondent.  
16 \_\_\_\_\_

) Cancellation No. 92044697  
) Reg. No. 2932593

) **RESPONDENT'S RESPONSES TO**  
) **PETITIONER'S FIRST SET OF**  
) **INTERROGATORIES**

17  
18 **Interrogatory No. 1:**

19 State the full name, address, state and/or country of incorporation, and form of business  
20 conducted by Respondent JEANNETTE MARTELLO using Respondent's Marks in connection  
21 with such business or enterprise.

22 **Response:**

23 Objection, the interrogatory is vague and ambiguous as to the time-frame requested.

24 Interpreting the interrogatory to ask for the most current information:

25 Jeannette Martello, MD, a Professional Corporation, 701 Fremont Avenue, Pasadena,  
26 California, 91030.

27 **Interrogatory No. 2:**

28 For each of the goods and/or services identified in the trademark applications for  
Petitioner Exhibit R-02  
Cancellation No. 92044697  
Page 1 of 3

Respondent's Marks,

(a) State the date of first use in intrastate commerce of the Respondent's Marks;

(b) Describe in what particular manner Respondent's Marks was first used with each of the goods and/or services, including without limitation signs, displays, promotional materials, advertising, business stationary, business cards, labels, and brochures;

(c) Identify each person who has knowledge about such first use.

**Response:**

"SKIN DEEP" Reg. 2932593; Serial No. 76581387

4/20/02;

"SKIN DEEP LASER MEDSPA" Serial No. 76579565

2/18/04;

"SKIN DEEP LASER" Serial No. 76581391

2/18/04

**Interrogatory No. 3:**

Identify and describe the services and/or goods, which the Respondent has sold, distributed, provided, advertised, marketed, or offered with Respondent's Marks or any variation of Respondent's Marks.

**Response:**

Medical services, plastic surgery, spa services, medi-surgical consultation services, med-spa services, skin care products (lotions, creams, sunscreens, body-washes, astringents, moisturizers, etc. – both prescription and over the counter), laser hair removal services, botox injections, collagen injections, etc.

**Interrogatory No. 4:**

With respect to Respondent's use of Respondent's Marks and/or any mark that includes the term "SKIN DEEP",

a. Identify the earliest date upon which Respondent intends to rely in this proceeding;

b. Identify all documents relating to such use(s); and

c. Identify all persons with knowledge of said use(s).

1 **Response:**

- 2 a. March 2001
- 3 b. Assignment Agreement between Sara Herrick, R.N. and Jeannette Martello, M.D.
- 4 c. Respondent, Sara Herrick.

5 **Interrogatory No. 5:**

6 Identify each different promotional material, including without limitation, signs, display,  
7 point-of-sale display, label, hangtag, wrapper, container, package, advertisement, brochure, and  
8 the like, which is known to Respondent, contains or bears Respondent's Marks or any variation  
9 thereof, and has been used or disseminated at any time by Respondent, and the location of said  
10 promotional materials or signs.

11 **Response:**

12 Signs, letterhead, labels, decals, stamps, advertisements, magazines, brochures, etc. All  
13 are in Respondent's possession.

14 **Interrogatory No. 6:**

15 Identify each person, including without limitation, employees or outside agency or agent  
16 retained by Respondent, who has been or now is responsible for the following activity with  
17 respect to any of the goods or services actually offered or rendered under Respondent's Marks:

- 18 a. Marketing;
- 19 b. Advertising and promotion; and
- 20 c. Bookkeeping and accounting.

21 **Response:**

22 a.-b. Melinda Manos, Amber Perry, Fred Bankston, Rebecca Fuller, Marianne Guarena,  
23 Marc Pfannenstein, Tracy Lima, Glen Lipton, Elaine Sense, Cinamour  
24 Entertainment, Peter Kempson, Igor Kantor, Liberty Int'l Interactive, Inc., Colin  
25 Macdonald, James Shafer, Lis Rubin, Jonathan Berry, Angel Parker, Linda  
26 Caldera, Stacey Castor, Nicole Smith, Nadia Perez, Marissa Buck, Alexandra  
27 Schinko, Shawn Blair, David Verdefo, Kellian Allen, Linda Oparnica, Irv